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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,027	01/09/2006	Jim Carothers	2380-560	4074
28839 7590 03/18/2008 TOMLINSON & O'CONNELL, P.C. TWO LEADERSHIP SQUARE 211 NORTH ROBINSON, SUITE 450 OKLAHOMA CITY, OK 73102				
EXAMINER				
FULLER, ROBERT EDWARD				
ART UNIT		PAPER NUMBER		
3676				
MAIL DATE		DELIVERY MODE		
03/18/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/564,027

Applicant(s)

CAROTHERS ET AL.

Examiner

ROBERT E. FULLER

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-42 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF 298)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

Election/Restrictions

1. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

2. The species are as follows:

Species I – A pipe burster usable with a single-member drill string.

Species II – A pipe burster usable with a dual-member drill string.

If species I is elected, further election is required between the following subspecies:

Subspecies Ia – Spherical bursting members aligned radially (see Figure 4).

Subspecies Ib – Spherical bursting members aligned longitudinally (see Figure 5).

If species II is elected, further election is required between the following subspecies:

Subspecies IIa – longitudinally aligned, recirculating spheres (see Figure 6).

Subspecies IIb – Having pipe-cutting blades forward of the frame (see Figure 7).

Subspecies IIc – Having a percussive tool assembly (see Figure 8).

Subspecies IId – Having a cutting member forward of the pipe burster (see Figure 9).

Subspecies IIe – The spherical members are supported by races (see Figure 10).

Subspecies II_f – Having an eccentric cam (see Figure 11).

Subspecies II_g – Having an eccentric flywheel (see Figure 12).

If subspecies II_e is elected, further election is required between the following sub-species:

Subspecies II_e(1) – Having a concentric biasing assembly (see Figure 13).

Subspecies II_e(2) – Having an eccentric biasing assembly (see Figure 14).

3. Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The claims are deemed to correspond to the species listed above in the following manner:

Claims 4 and 17 are generic to subspecies II_b and subspecies II_a.
Claims 5 and 18 are generic to subspecies II_a and subspecies II_b-II_g.
Claims 6, 19, and 29 are directed to subspecies II_b.
Claims 7 and 20 are directed to Species II.
Claims 8 and 21 are directed to subspecies II_a.
Claims 9, 22, 31, and 33 are directed to subspecies II_d.
Claims 10 and 23 are directed to subspecies II_e.
Claims 11 and 24 are directed to subspecies II_f.
Claims 12 and 25 are directed to subspecies II_g.

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Claims 13 and 32 are directed to subspecies IIc.
Claims 26 and 27 are directed to species II.
Claim 28 is directed to subspecies IIa.
Claim 30 is directed to subspecies IIa.
Claim 34 is generic to subspecies IIe(1) and IIe(2).
Claim 35 is directed to subspecies IIe(1).
Claims 36-38 are directed to subspecies IIe(2).
Claim 42 is directed to subspecies IIa.

The following claim(s) are generic: Claims 1-3, 14-16, and 39-41.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons:

To share a special technical feature that is inventive, the shared feature must be novel and unobvious over prior art. In this case, Bateman (US 3,818,734) teaches a pipe-bursting apparatus (5) for use with a drill string (connected via threads 16), the apparatus comprising a frame (7) connectable with the drill string; and at least one substantially spherical pipe-bursting member (6) supported by the frame and operable in response to movement of the drill string.

All the claims cannot share an inventive special feature, as the special feature of claim 1 is known. Therefore, claim 1 is not inventive and the claims lack unity.

4. Because of the complexity of the restriction, no telephone call to the applicant was made.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **ROBERT E. FULLER** whose telephone number is (571)272-0419. The examiner can normally be reached on Monday thru Friday from 8:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer H. Gay can be reached on 571-272-7029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jennifer H Gay/
Supervisory Patent Examiner, Art
Unit 3676

03/11/2008

REF